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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,236	08/27/2001	Gilbert Garitano	DERMA-06458	4147
23535	7590	03/24/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,236

Applicant(s)

GARITANO, GILBERT

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1774

DETAILED ACTION

Response to Amendment

The Examiner acknowledges the request for continued examination.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-13, 24-28, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9-13, 24-28, and 30 contains the trademark/trade name CORIAN®, GIBALTAR®, SOLID SURFACING VENEER (SSV)®, FOUNTAINHEAD®, AVONITE®, or CERATA®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an article of manufacture and, accordingly, the identification/description is indefinite. See MPEP 2173.05(u).

Replacement of trademarked terms with a generic description is advised.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 14-24, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,800,904 to Hallman et al. in view of USPN 6,203,911 to Weberg et al.

4. Hallman teaches an embossable surface covering with inorganic wear layer. At col. 7, line 33-col. 8, line 10 Hallman discloses the following: A support layer may be any of the class of filled or unfilled organic polymeric materials that are typically used as support structures in the floor products industry, for the manufacture of sheet goods, tile, or other substrates such as wall, ceiling or laminate structures. Examples of such support structures as floor covers with an embossed inorganic wear layer, include highly filled polyester thermoset resins, filled acrylates such as corean (Corian equivalent). Decorative images may be formed on the top side of the support layer 3 by any of a number of standard printing and decorating techniques. These techniques include thermal transfer, rotogravure printing, lithographic printing, hot stamping, and dye sublimation. Hallman does not disclose an inorganic filler of 1a) per instant claim 1 or adding inorganic fillers in the specific composition as instant claims 3, 5-8, 18-23, and 29 within ranges from 20-85 wt % or the PMMA from 15-80. However, Weberg teaches inorganic fillers such as alumina trihydrate can be included in a

Art Unit: 1774

polymeric material of PMMA from 10 to 75 weight % at col. 8, line 36. PMMA is added in a wt% no greater than 25%. See col. 6, line 61. Weberg explains alumina trihydrate is the preferred filler for PMMA systems because the index of refraction is close to each other and can provide a desired appearance. Weberg also explains filled polymeric material may be included in a decorative composition as described above (see col. 8, line 43). Hence it would have been obvious to one of ordinary skill in the art to modify the covering of Hallman to include alumina trihydrate and PMMA because the addition increases the strength of a molded article as taught by Weberg at col. 8, lines 1-2 and appearance via refractive indices adjustments also taught by Weberg at col. 8, lines 30-35.

Hallman does not teach the fixed image having a "corresponding transfer image", which is described in Applicant's disclosure as dye that has been transferred to a solid surface which changes the visual appearance. However, the optical density value of the fixed image to the "corresponding transfer image" is not a positive recitation in the claim and so is given no patentable weight. The "corresponding transfer image" is not part of the claim as written. Regarding claim 15, the optical density of the fixed image would be inherent as the same materials are used in the same manner. Any properties exhibited would be expected to be the same absent any evidence to the contrary.

5. Claims 10-12, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,800,904 to Hallman et al. in view of USPN 6,203,911 to Weberg et al. and further in view of USPN 5,826,396 to Michaels.

6. Hallman is relied upon above. Hallman does not teach adding GIBALTAR®, FOUNTAINHEAD®, or AVONITE®. Michaels teaches countertops and provides the

Art Unit: 1774

aforementioned trademarked terms including CORIAN® are known plastic solid surfacing materials commonly used in building countertops, walls, shower surrounds, and other building structures. See the Abstract and col. 1, lines 14-40. It would have been obvious to one of ordinary skill in the art to modify the surface covering of Hallman to substitute GIBRALTAR®, FOUNTAINHEAD®, or AVONITE® because Michaels provides they are common materials for use in building structures and are therefore functional equivalents. These materials would be expected to behave in the same manner absent any evidence to the contrary.

Response to Arguments

Applicant's arguments been considered but are moot in view of the new ground(s) of rejection. Weberg is still used in the rejection to provide for the PMMA and ATH inclusions and weight percentage ranges.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus
Examiner
Art Unit 1774

March 17, 2004

DISCLOSURE
EXAMINER
2004

Cynthia Kalf